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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

SAF041.238626

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Application Number

10/619,154

Filed

July 14, 2003

First Named Inventor

James Patrick Griffin

Art Unit

3634

Examiner

G. Strimbu

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

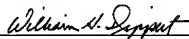
☐ assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/95)

☒ attorney or agent of record. 26,723
Registration number _____

☐ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____



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June 15, 2007

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

James Patrick Griffin et al.	:	Examiner:	G. Strimbu	
Serial No.:	10/619,154	:	Art Unit:	3634
Filed:	July 14, 2003	:	Confirmation No.:	6780
For:	SECURITY DEVICE FOR A DOOR			

June 15, 2007

Mail Stop: AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

SIR:

In connection with a request for a pre-appeal panel review, Applicants hereby provide the following comments:

Claims 50 and 51 have been cancelled in a concurrently filed Supplemental Amendment Under 37 C.F.R. 1.116.

IT WAS IMPROPER TO COMBINE SMITH AND BARNES

The Examiner has combined Smith, British Patent Application No. 2,265,664 ("Smith") and Barnes, U.S. Patent No. 306,806 ("Barnes"), each of which has its individual shortcomings as a reference (as discussed below), to sustain a rejection under 35 U.S.C. § 103(a). Smith teaches a security system for a wooden door or window, and Barnes teaches a door-protector for a wooden door with anti-warping longitudinal components and a mortise lock-area reinforcement

component. Applicants respectfully maintain that the Examiner's position in combining these two references is fatally flawed because the Examiner has not indicated the reason why one skilled in the art would have combined these two references to incorporate the anti-warping components from Barnes into the security system of Smith. More specifically, the Examiner has not delineated an apparent purpose for which one skilled in the art would combine Smith and Barnes. KSR Intl. v. Teleflex Inc., ___ U.S. ___ (S.Ct. 2007); USPTO Memorandum dated May 3, 2007. For that reason alone the rejections under § 103(a) should be withdrawn.

**EVEN IF COMBINED, SMITH AND BARNES DO NOT
SUGGEST APPLICANTS' INVENTION**

With regard to Smith and Barnes, each of these references is deficient as a reference for different reasons. Smith discloses a security device for a wooden door or window comprising a first, C-shaped plate and a jamb plate. The C-shaped plate is intended to be slipped over the edge of a wooden door or window in the proximity of a locking means. The jamb plate is intended to provide reinforcement to a frame or jamb surrounding the door or window.

Smith differs from the claimed invention in at least three ways. First, although the Examiner characterized the C-shaped plate of the Smith device as "extending along the full length of the free vertical edge portion of the door ...," this is not the same as the limitation of each of Claims 30 and 40 that the first reinforcing member extend "substantially along the length of the free vertical portion of the door ..." (emphasis added). In fact, this mischaracterized feature of Smith is not the same as, and is distinctly different from, Applicants' claim limitation. Having a member along the portion of the door in the vicinity of the locking means (see, for example, page 2, lines 12-15, of Smith) is far different from a reinforcing member that extends substantially the full length of the free vertical edge portion of the door.

There is no teaching or suggestion that the C-shaped plate of Smith is intended to extend substantially along the edge of a door beyond the proximity of any locking means, as is required by Applicants' claims. This is significant since the limited size of the Smith C-shaped plate means that it will not and can not function to transmit force along the longitudinal edge of a door as occurs according to Applicants' invention.

In his remarks in the Office Action the Examiner commented (pages 9-10) that Smith disclosed that member 2 "may be any suitable height or width..." and that member 2 is not clearly intended to be positioned around the locking mechanism. Applicants respectfully suggest that this partial quotation is misleading. Rather, the quoted language has a different meaning when considered in the context of the remainder of the sentence, which reads as follows:

"... in order to reinforce or strengthen the door or window in the proximity of as many locking mechanisms as are required." (Emphasis added.)

The totality of the sentence is unquestionably supportive of Applicants' position that Smith does not teach or suggest that the C-shaped member should extend substantially the length of the vertical free edge portion of the door but, rather, that the C-shaped plate is meant to be in the vicinity of the locking mechanism(s).

Second, in Claims 30 and 40 the second reinforcing member has a length of from about 12 inches to substantially the length of a vertical portion of the door. Again, in contradistinction, Smith does not teach or suggest that the actual length of the jamb member will be any more than around the locking mechanism(s).

And third, as has been discussed extensively with the Examiner, the trapezoidal cross-section of the first reinforcing member of the claimed invention differs from the C-shaped cross-section of the corresponding member in the Smith device. Applicants reiterate that "fit snugly" is not the same as a U-shaped member over-bend mounted and having a cross-section with a tapered, essentially trapezoidal shape that firmly engages the edge of a door to achieve a frictional fit, as happens according to Applicants' invention. The fact that Smith teaches securing the C-shaped member to the door with 32(!) screws to keep the member from falling off (Fig. 1; page 6, lines 2-4) is a clear indication that "fit snugly" is not the same as the frictional fit engagement that is achieved according to Applicants' invention.

Barnes discloses a door protector adapted to be used on the front edges of wooden doors to prevent their warping out of shape. The door protector primarily consists of a flat metallic plate having a width corresponding to the thickness of the door and having a length the same as that of the door. The flat metallic plate is attached to the edge of the door by linearly spaced

screws. The door protector also has flanges to strengthen the door at the point which has been weakened by the mortise into which the mortised lock usually employed is inserted.

The Examiner has combined Smith with Barnes due to Barnes' apparently longitudinally extending flat member. As indicated above, the Examiner's combination of Smith and Barnes is fatally flawed since it doesn't meet the Supreme Court's guidelines for combining references. The Examiner's conclusory statement at page 7 of the Office Action that it would have been obvious to combine Smith's U-shaped reinforcing member with Barnes' length is not supported by the references, or even by simple logic. And, even if the Smith and Barnes references were combined, what do you get? At best you get a combination security device/anti-warping door protector where the C-shaped member of the Smith device might have flanges around the locking mechanism to provide more strength there and vertically extending flat pieces to prevent the wooden door from warping, with linearly spaced screws that will weaken the door and make it more vulnerable to attack. There is nothing in this Rube Goldberg combination that is at all close to the amazingly effective security system represented by Applicants' invention.

Moreover, the combination of features or elements from Smith and Barnes that the Examiner maintains would be obvious to one skilled in the art to make a better security system would very likely have the opposite effect. More specifically, the combination that the Examiner proposes of the Smith two-plate security combination with the anti-warping components described by Barnes would result in whatever security is provided by Smith's apparatus being compromised by the inherent weakness created in the edge of the door by the linearly spaced screws used to fasten Barnes' flat device to the door edge. Thus, adding the flat pieces from Barnes with its door-weakening, linearly spaced screws to Smith's device would lead one skilled in the art away from Applicants' invention rather than toward it.

The Examiner mentioned, without attribution, that "one of ordinary skill in the art is expected to routinely experiment with parameters so as to ascertain the optimum or workable range for a particular use" This statement does not apply here for at least two reasons: First, neither Smith nor Barnes teaches particular parameters within which Applicants were supposedly working. And second, if the supposed parameters relate to opposing longitudinally extending members, Barnes teaches away from a situation where opposing longitudinal members would be

substantially coextensive because Barnes only discloses that there will be a single, unopposed, flat, longitudinally extending anti-warping member.

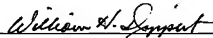
Applicants previously provided a Declaration of James P. Griffin, Jr., one of the inventors. Mr. Griffin provided comments regarding the Smith and Barnes references as well as information regarding the unexpected commercial success thus far of the DOOR SAFE SYSTEMS™ door security system corresponding to the claims herein. Applicants respectfully submit that the Examiner's comments regarding the Declaration were inappropriate. Mr. Griffin presented a showing of commercial success and interest based upon sales that were unexpectedly good in view of the limited promotion. There was no market to compare the sales to since this was the only product of its specific type. Moreover, the Examiner's requirement of a "nexus" is not applicable here.

Applicants respectfully suggest that Smith and Barnes should not have been combined, that, regardless, the combination of Smith and Barnes does not suggest Applicants' invention, and that the rejections under § 103(a) should be withdrawn.

Reconsideration and allowance of all the claims herein are respectfully requested.

Respectfully submitted,

June 15, 2007



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